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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,275	11/07/2001	Irshad A. Rana		2231

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IRSHAD A. RANA
43686 SKYE ROAD
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EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,275

Applicant(s)

RANA, IRSHAD A.

Examiner

Karl D. Frech

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Applicant currently begins the Specification with the Abstract and Claims, the sections are "out of order". The examiner acknowledges that applicant has provided the abstract and the claims on separate sheets as required by the Pre-exam Formalities Notice of 3/11/2002. This is much appreciated. However, the abstract and claims as seen in the

beginning of the written description as originally filed should be cancelled from the written description. More specifically, the examiner suggest that applicant should amend the "specification" to cancel page 1 line 1 through page 3 line 7, i.e. everything before the section titled "BACKGROUND OF THE INVENTION".

1. Claims 4-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim, regarding claims 4,5,16, must refer to previous claim in the alternative only; regarding claims 5,16, must not refer to another multiple dependent claim; regarding claims 5-16 must not refer to an another improper multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-16 have not been further treated on the merits.

What is meant by referring to previous claims in the alternative only, it is meant that claims 4,5 and 16 cannot refer to previous claims in the "and", but in the "or" terminology. For example, current claim 4 refers to "claims 1,2 and 3". This is improper. If it desired, applicant should refer to "claims 1,2 or 3".

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure that goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the US patent(s) cited.

Regarding claim 1: there are several instances in the claims that render the claims vague and indefinite. Applicant claims "beads (1), magnetic or nonmagnetic of any configuration", which is interpreted as simply being "any" bead. However, later in the claim the applicant calls for "sensing the magnetic rosary beads". This contradicts the recitation of magnetic or nonmagnetic as the claim now calls for a specific type of bead.

Applicant also includes words in parenthesis. In the first instance "(tusbeeh)" should be cancelled as tusbeeh is not in the English language. In the second instance "(say clockwise)" is a suggestive statement that renders the claim vague. Claim must be positively recited. In the third instance "(wound, on a plastic thread)" is a positive limitation, and may remain in the claim, but must be taken out of the parenthesis. In the claims, parenthesis "(" & ")" are reserved for indicating reference numbers.

Also, the current claim 1 is currently 5 sentences long. Claims can only be 1 sentence long. The claim must end in a period, but any intermediate periods should be replaced by alternate punctuation.

Regarding claim 2: similar to that as seen above, this claim now calls for a specific non-magnetic bead. This contradicts the original recitation in the claims that the bead can be "magnetic or nonmagnetic of any configuration". Also, there is no period to end the sentence.

Regarding claim 3: similar to that as seen above, this claims now calls for a specific non-magnetic bead. This contradicts the original recitation in the claims that the bead can be "magnetic or nonmagnetic of any configuration". Also, this claim contains words in parenthesis.

Regarding claims 4-16: these claims appear to contain similar shortcomings to those listed above. However, due to the improper multiple dependent nature of claims 4-16, the examiner is restrained in examination of these claims on their merits.

4. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Note: The examiner has broadly interpreted claims 1-3 for the substance of the invention. Although the examiner can not indicate allowability of the claims due to their current indefinite nature, the examiner has not yet found "prior art" upon which he can

rely for a "prior art" rejection under 35 USC 102 or 103. It is noted that a patent professional may be able to adequately amend the current claims to clearly and positively claim the applicant's invention, which may, depending upon any amendment, render the claims allowable.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dewolf et al 4,365,246, Delvecchio et al 2005/0026120, Wexler 2002/0142275, DeWolf et al 4,601,584 and Wexler 6,540,519 are all US Patents or published applications showing electronic rosaries. It is suggest applicant review these references for their content, as well as their form. WO 01/48720 discloses an electronic rosary and JP 2001-61975 discloses a string of prayer beads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech
Primary Examiner
Art Unit 2876
